



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,800	09/19/2003	Gregory Scott Clark	215.1014.02	3481
22883 7590 05/16/2007 SWERNOFSKY LAW GROUP PC P.O. BOX 390013 MOUNTAIN VIEW, CA 94039-0013			EXAMINER LY, CHEYNE D	
			ART UNIT 2168	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,800

Applicant(s)

CLARK, GREGORY SCOTT

Examiner

Cheyne D. Ly

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicants' arguments filed February 05, 2007 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
2. The objects and rejections in the Office Action, July 26, 2006, have been withdrawn as necessitated by claim amendments. Applicant's argument is moot in light of the withdrawal of said objects and rejections.
3. The rejections in the instant Office Action has been necessitated by claim amendments.
4. The amendment to the specification has been entered.
5. Claims 1-16 are pending.
6. Claims 1-6 are withdrawn.
7. Claims 7-16 are examined on the merits.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 7-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 2168

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. NEW MATTER.

10. Claim 7, lines 11-12, recites “translating said set of universal part numbers into a second set of proprietary part number; and generating a second document using the second set of proprietary numbers...” wherein the new limitation has not been found in the instant specification. It is noted that page 14, lines 16-22, recites “the translation module looks to the true proprietary numbers and translates them back to the numbers that were originally provided by the user 135 in step 315...generates a BOM...” However, the disclosure of “the true proprietary numbers...back to the numbers that were originally provided” does not provide written support for the new limitation of “translating said set of universal part numbers into a second set of proprietary part number.” The same issue is present in claim 12.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinckley (US 2002/0055886 A1).

13. In regard to claims 7, 9, and 10, Hinckley a method for translating a document that includes a set of proprietary part numbers over a network (page 8, [0097], especially, “Bill of

Art Unit: 2168

Materials...to electronically create, share...BOM line items may be translated...”), including the steps of

receiving a first document (page 8, [0097], especially, “Bill of Materials...to electronically create, share...BOM line items may be translated...”) including a first set of proprietary part numbers from a client workstation (page 3, [0043], especially, “IPN” for internal part number, and [0045], especially, “an input/output interface”), wherein a user of said client workstation...

translating said first set of proprietary part numbers into a set of proprietary part numbers into a set of universal part numbers (page 5, [0063]-[0068], especially, “Universal Part Number (UPN)”),

determining availability of one or more parts associated with said set of universal part numbers (page 7, [0081]-[0084], especially, “the user wants to search...the MCR module may identify the corresponding UPN and capture records associated with the UPN),

translating said set of universal part numbers into a second set of proprietary part numbers (page 7, [0083], especially, “the MCR module may match all records that have the same UPN...return a listing of the unique IPN, CBs’ identification data MPN...”),

generating a second document that summarizes a transaction involving the parts (page 9, [0106], especially, “POs” and “invoices”).

14. However, Hinckley does not explicitly describe generating the second document using the second set of proprietary part numbers.

15. Hinckley describes an improvement that benefits component buyers (CBs) by reducing procurement cycle time and improved access to competitive pricing and available inventories

(page 9, [0103]). “The order module may provide an integrated solution that enables CBs and CSs [component sellers] to collaborate electronically with all of the trading partners in the supply chains...creating POs” (page 9, [0106]). Further, Hinckley describes the improvement “enable tracking IPN links to each CS and CB account.”

16. One of ordinary skill in the art at the time of the invention would have been motivated by the improvement of Hinckley to generate the second document using the second set of proprietary part numbers such as IPNs to reduce procurement cycle time and improve access to competitive pricing and available inventories by tracking IPN linked to each CS and CB account. Therefore, it would have been obvious to one of ordinary skill in the art to generate the second document using the second set of proprietary part numbers such as IPNs.

17. In regard to claim 8, Hinckley describes each of said set of universal part numbers is associated with other part numbers such as may be associated with different suppliers and manufactures (page 5, [0062]-[0063], especially, UPN and “associated MPN” (manufacture part number).

18. In regard claim 11, Hinckley describes identifying what parties may create associations between part numbers or enter new part numbers (page 6, [0061], especially, “register and store the identity(s) of entities providing such inaccurate data...allow the system and/or system operators or administrators to prioritize the equivalency data...).

19. In regard to claims 12-16, Hinckley describes the memory (page 1, [0008] and FIG 3).

CONCLUSION

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The


Art Unit: 2168

USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

23. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly 
Patent Examiner
4/28/07